



AF / GP3732

PATENT

Customer No. 22,852

Attorney Docket No. 05725.0869-02000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:)

Jean-Louis H. GUERET)

) Group Art Unit: 3732

Application No.: 09/809,268)

) Examiner: Eduardo C. ROBERT

Filed: March 16, 2001)

For: PRODUCT APPLICATOR AND)
PACKAGING UNIT COMPRISING)
SUCH APPLICATOR)

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Mail Stop Appeal Brief--Patents

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

TRANSMITTAL OF APPEAL BRIEF (37 C.F.R. 1.192)

Transmitted herewith in triplicate is the APPEAL BRIEF in this application with respect to the Notice of Appeal filed on September 23, 2003.

This application is on behalf of

☐ Small Entity ☒ Large Entity

Pursuant to 37 C.F.R. 1.17(f), the fee for filing the Appeal Brief is:

☒ \$330.00 (Large Entity)**TOTAL FEE DUE:**

Notice of Appeal Fee \$330.00

Terminal Disclaimer Fee \$110.00

Extension Fee \$110.00

Total Fee Due \$550.00


☒ Enclosed is a check for \$550.00 to cover the above fees.FINNEGAN
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PETITION FOR EXTENSION. If any extension of time is necessary for the filing of this Appeal Brief, and such extension has not otherwise been requested, such an extension is hereby requested, and the Commissioner is authorized to charge necessary fees for such an extension to our Deposit Account No. 06-0916.

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: December 23, 2003

By: _____


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PATENT
Customer No. 22,852
Attorney Docket No. 5725.0869-02

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:

Jean-Louis H. GUERET

Application No.: 09/809,268

Filed: March 16, 2001

For: PRODUCT APPLICATOR AND
PACKAGING UNIT COMPRISING
SUCH APPLICATOR

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) Examiner: E. ROBERT
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Sir:

APPEAL BRIEF UNDER 37 C.F.R. § 1.192

Pursuant to 37 C.F.R. § 1.192, Appellant submits this Appeal Brief, in triplicate, to the Board of Patent Appeals and Interferences. In the April 23, 2003 final Office Action, the Examiner finally rejected claims 136-152, 156, 161, 163, 174, 175, 179, 189, and 190. A Notice of Appeal having been filed on September 23, 2003, and the period for filing this Appeal Brief being extended to December 23, 2003 by the concurrently-filed Petition for Extension of Time, this Appeal Brief is being timely filed along with the corresponding Appeal Brief fee payment.

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I. Real Party In Interest

The real party in interest is L'Oréal, the assignee of the entire right, title, and interest in the application.

II. Related Appeals and Interferences

There are currently no appeals or interferences related to this application that are awaiting decision by the Board of Patent Appeals and Interferences.

III. Status Of Claims

Claims 23-222 are pending. Claims 136-152, 156, 161, 163, 174, 175, 179, 189, and 190, as set forth in the attached Appendix, were rejected in the final Office Action. Claims 23-135, 153-155, 157-160, 162, 164-173, 176-178, 180-188, and 191-222 were withdrawn from consideration as being directed to a non-elected species. Appellant is uncertain of whether claims 138-145 and 147 have been withdrawn in addition to being rejected inasmuch as the Office Action dated October 22, 2002 indicates those claims are both withdrawn and rejected, and there is no clarification of that ambiguity in the final Office Action.

Rejected claims 136-152, 156, 161, 163, 174, 175, 179, 189, and 190 are involved in this appeal. As mentioned above, those claims are set forth in the attached Appendix.

IV. Status Of Amendments

No amendments have been filed subsequent to the final rejection of claims 136-152, 156, 161, 163, 174, 175, 179, 189, and 190 in the final Office Action dated

April 23, 2003.¹ Appellant is filing herewith a Terminal Disclaimer to obviate an obviousness-type double patenting rejection discussed below.

V. Summary Of Invention

The subject matter of the rejected claims relates to a cosmetic product applicator and a method of applying a cosmetic product using the applicator. The applicator includes an elongated flexible support, an application portion at one end of the support, and a gripping portion at the opposite end of the support. *See, e.g.*, page 2, lines 24-25. The support includes first and second planar surfaces facing away from one another. *See, e.g.*, FIGS 1-8. The applicator also includes a layer of a spongy flexible material having a greater flexibility than the flexibility of the support. *See, e.g.*, page 2, line 27 – page 3, line 2.

Since the embodiment of FIG. 4 was selected in response to the Election of Species Requirement dated July 8, 2002, further description of the exemplary embodiment of FIG. 4 follows. As described in the specification, the exemplary applicator 1 shown in FIG. 4 has features in common with those of the exemplary applicator shown in FIG. 2, which in turn has features in common with those of the exemplary applicator shown in FIG. 1. *See, e.g.*, page 8, lines 11-12; page 8, line 27 to page 9, line 1.

¹ On July 23, 2003, Applicant filed a Petition to Group Director of Technology Center 3730 under 37 C.F.R. § 1.144 Requesting Reconsideration and Reversal of the Examiner's Withdrawal of Claims Pursuant to an Election of Species Requirement. Since a decision on the Petition was not received by September 23, 2003, Applicant filed a Resubmission of the Petition, but Applicant has still not received a decision. Accordingly, Applicant has again resubmitted the Petition on November 24, 2003 and awaits a decision from the U.S. Patent and Trademark Office on the Petition. Since, as discussed in the following, Appellant believes the rejection of claims 136-152, 156, 161, 163, 174, 175, 179, 189, and 190 is improper, the present appeal ensued.

The applicator 1 of FIG. 4 includes a semi-rigid strip-shaped support 2 (for example, cardboard) having a longitudinal core and two parallel sides 14, 18. *See, e.g.*, page 7, lines 14-16. The applicator 1 has an application portion 4 and a gripping portion 6. *See, e.g.*, page 7, lines 16-17. At the application portion 4, the support sides 14, 18 are covered by respective layers 16a, 16b of a first and a second soft spongy material which are different from each other. *See, e.g.*, page 9, lines 1-3. At the gripping portion 6, the support sides 14, 18 are covered by respective layers 16c, 16d of a third and a fourth soft spongy material which differ from each other and from the materials of layers 16a, 16b. *See, e.g.*, page 9, lines 4-7.

The flexibility of one or more of the layers 16a, 16b, 16c, 16d may be greater than the flexibility of the support 2. *See, e.g.*, page 2, line 26 – page 3, line 2; page 7, lines 23-24. Furthermore, the thickness of one or more of the layers 16a, 16b, 16c, 16d may be greater than that of the support 2. *See, e.g.*, page 7, lines 24-25.

When the user wishes to make up a surface region, for example, eyelids, the user grips the gripping portion 6 between her forefinger and thumb. *See, e.g.*, page 2, line 26 – page 8, line 1. After having loaded the applicator portion 4 with the product, she applies it to the eyelid and then spreads the product by displacing the applicator over the eyelid. *See, e.g.*, page 8, lines 1-3.

VI. Issue

Whether the rejection of claims 136-151, 163, 189, and 190 under the judicially-created doctrine of obviousness-type double patenting over claims 1-16 of U.S. Patent No. 5,913,318 should be reversed

Whether the rejection of claims 136, 137, 146, 148-152, 156, 161, 163, 174, 175, 179, 189, and 190 under 35 U.S.C. § 102(b) based on U.S. Patent No. 3,179,108 to Bloch et al. ("Bloch") should be reversed.

VII. Grouping of Claims

Regarding the obviousness-type double patenting rejection, claims 136-151, 163, and 190 stand or fall together.

Regarding the rejection under 35 U.S.C. § 102(b), each of claims 136, 137, 146, 148-150, 163, 174, and 175 stand or fall together; claims 156 and 161 stand or fall together; and each of claims 151, 152, 179, 189, and 190 stands or falls on its own.

VIII. Arguments

A. Summary of the Arguments

The rejection of claims 136-151, 163, 189, and 190 under the judicially-created doctrine of obviousness-type double patenting should be reversed because, as mentioned above, Applicant has filed a Terminal Disclaimer herewith, thereby obviating the obviousness-type double patenting rejection.

The rejection of claims 136, 137, 146, 148-152, 156, 161, 163, 174, 175, 179, 189, and 190 under § 102(b) should be reversed because Bloch lacks any disclosure or suggestion of an elongated flexible support having first and second planar surfaces, as recited in independent claim 136. To the contrary, Bloch discloses a tubular stick with no such planar surfaces.

Additionally, the § 102(b) rejection should be reversed because Bloch does not disclose or suggest an application portion at one end of the support and a gripping portion at another opposite end of the support, as recited in claim 136. Instead, Bloch discloses application portions at both ends of the tubular stick.

B. Detailed Arguments

- 1. The rejection of claims 136-151, 163, 189, and 190 under the judicially-created doctrine of obviousness-type double patenting over claims 1-16 of U.S. Patent No. 5,913,318 should be reversed because Applicant has filed a Terminal Disclaimer to obviate the rejection**

As previously mentioned, Applicant has filed a Terminal Disclaimer herewith, thereby obviating the obviousness-type double patenting rejection over claims 1-16 of U.S. Patent No. 5,913,318. Accordingly, Applicant submits that the obviousness-type double patenting rejection of claims 136-151, 163, 189, and 190 should be reversed for at least this reason.

- 2. The rejection of claims 136, 137, 146, 148-152, 156, 161, 163, 174, 175, 179, 189, and 190 under 35 U.S.C. § 102(b) should be reversed because Bloch lacks any teaching of, *inter alia*, a support having first and second planar surfaces, an application portion at one end of the support, and a gripping portion at an opposite end of the support, as recited in claim 136**

a. Bloch

Bloch discloses an absorbent swab type applicator 15 comprising a thin-walled hollow thermoplastic stick 16 and wads 17 of absorbent fibrous material secured to each end of the stick 16. Col. 3, lines 29-31. The plastic stick 16 is formed of a relatively thin-walled hollow tubing having protruding longitudinal ridges 25 formed in the outside surface of the stick. Col. 4, lines 10-11, 18-20. Bloch does not disclose or

suggest any planar surface on the plastic stick 16, nor does Bloch disclose or suggest relative dimensions of the stick 16 and the wads 17.

Bloch discloses that the wads 17 at each end of the stick 16 are used for cleaning aural and nasal passages and for cosmetic purposes. Col. 1, lines 10-14. Bloch does not disclose or suggest that either wad 17 is configured so that it may be gripped during use.

b. Bloch does not disclose or suggest “an elongated flexible support having a first planar surface and a second planar surface,” as recited in claim 136

Bloch does not disclose or suggest an applicator including, *inter alia*, “an elongated flexible support having a first planar surface and a second planar surface,” as recited in claim 136. To the contrary, as discussed above, Bloch discloses an applicator having a hollow tubular stick 16 with protruding longitudinal ridges 25 on its outside surface. By definition, a tubular stick 16 does not include a planar surface, nor do the longitudinal ridges 25, as shown in Figs. 2 and 4 of Bloch.

In the Office Action, the Examiner alleges that Fig. 3 of Bloch discloses a cross-section of the absorbent swab 15 that “has what can be considered upper and lower planar surfaces.” The Examiner also included an annotated copy of Fig. 3 (attached hereto) with the Office Action dated April 3, 2003, including notations apparently reflecting the Examiner’s allegations concerning first and second planar surfaces. Applicant disagrees with the Examiner’s allegations and submits that the portions identified by the Examiner in Fig. 3 are not planar surfaces.

A “surface” refers to a face of a solid, whereas a “cross-section” is a drawing of a plane exposed by cutting through something. American Heritage College Dictionary, 3d

ed., 1997. The alleged planar surfaces of Fig. 3 are not actual faces of the absorbent swab 15, but instead illustrate a cross-sectional view of the swab 15 along line 3-3 of Fig. 1. Indeed, Fig. 3 merely shows an imaginary representation that would result in the event Bloch's applicator would be cut in a plane along line 3-3 of Fig. 1. Such an imaginary representation cannot be considered as disclosing first and second planar surfaces.

Furthermore, Applicant submits that the cross-sectional views of Figs. 2 and 4 of Bloch do not support the Examiner's allegations that the swab 15 has planar surfaces. Indeed, as shown in Figs. 2 and 4 of Bloch, the stick 16 of swab 15 has a tubular shape with no planar surfaces. Moreover, nothing in the written text of Bloch supports the Examiner's allegations regarding the swab 15 having planar surfaces. Accordingly, Bloch does not disclose, teach, or suggest a support having a first planar surface and a second planar surface, as recited in claim 136. Therefore, the § 102(b) rejection of claim 136 should be reversed for at least this reason.

c. Bloch does not disclose or suggest an application portion at a first end of the support and a gripping portion at the second, opposite end of the support, as recited in claim 136

Bloch does not disclose or suggest an applicator including, *inter alia*, "an application portion at a first end of the flexible support" and "a gripping portion at a second end of the flexible support opposite the first end," as recited in claim 136. Instead, as previously mentioned, Bloch discloses an applicator having absorbent wads 17 at both ends of the tubular stick 16. Further, Bloch discloses that the absorbent wads 17 are used for cleaning aural and nasal passages and for cosmetic purposes. Bloch does not explicitly disclose that either of the wads 17 is configured to be gripped

during use. Moreover, Applicant submits that one of ordinary skill in the art would not consider either one of the wads 17 to be part of a gripping portion since conventional swab applicators, such as that shown in Bloch, are gripped by grasping the stick in between the absorbent ends. Since there is no express or implicit disclosure supporting the Examiner's apparent allegation that one of the wads 17 would constitute a gripping portion, it appears to Applicant that the Examiner is relying on a theory of inherency in alleging that one of the wads 17 may be considered to be a gripping portion.

Applicant disagrees with the Examiner's apparent inherency allegation and submits that "[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic." M.P.E.P. § 2112 (emphasis in original.) To establish inherency, the Examiner must show that "the missing descriptive matter is necessarily present" in the reference. See M.P.E.P. § 2112 (quoting *In re Robertson*, 49 U.S.P.Q.2d 1949 (Fed. Cir. 1999)). Furthermore, "[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teaching of the applied prior art." *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (B.P.A.I. 1990) (emphasis in original).

In the present case, the Examiner has failed to establish that either of the absorbent wads 17 disclosed in Bloch necessarily constitutes a gripping portion. To the contrary, Bloch explicitly discloses that the wads are used for cleaning aural and nasal passages and for cosmetic purposes. Since the wads have this disclosed use, neither wad is necessarily associated with a gripping portion. Moreover, a person using the applicator as taught by Bloch would not normally grip either wad for fear of

contaminating the wad before the wad is placed in contact with a surface region of a human body.

Consequently, Bloch in no way discloses or suggests “an application portion at a first end of the flexible support” and “a gripping portion at a second end of the flexible support opposite the first end,” as recited in claim 136. Thus, for at least this reason, Applicant submits that the § 102(b) rejection of claim 136 and claims 137, 146, 148-152, 156, 161, 163, 174, 175, 189, and 190 depending therefrom should be reversed.

d. Claims 156 and 161

In a statement apparently directed to claim 156 and/or 161, the Examiner asserted that in Bloch, the “layers of spongy flexible material appears [sic] to be thicker than [the] support.” Applicant respectfully disagrees and submits that when the disclosure of a reference gives no indication that the drawings are to scale, “it is well established that patent drawings do not define the precise proportions of the elements and may not be relied on to show particular sizes if the specification is completely silent on the issue.” *Hockerson-Halberstadt, Inc. v. Avia Group Int’l*, 222 F.3d 951, 956, 55 U.S.P.Q. 1487, 1491 (Fed. Cir. 2000).; *see also*, M.P.E.P. § 2125. Bloch does not indicate that the drawings are to scale and does not disclose the size of, or dimensional relationships between, the stick 16 and the wads 17.

Nothing in Bloch teaches or suggests spongy flexible material including “a thickness that is greater than a thickness of the flexible support,” as recited in claims 156 and 161. For that additional reason, the rejection of claims 156 and 161 should be reversed.

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e. Claims 151, 152, 179, 189, and 190

In addition, Bloch does not disclose or suggest that “at least part of the layer of the second spongy flexible material is at the gripping portion,” as recited in claim 151. Nor does Bloch disclose or suggest “a layer of a third spongy flexible material at the application portion,” as recited in claim 152.

Further, nothing in Bloch discloses or suggests “gripping the gripping portion between a user’s finger and thumb,” as recited in claim 179.

Additionally, Bloch does not disclose or suggest a “gripping portion ... configured in the form of a handle,” as recited in claim 189, nor does Bloch disclose or suggest a gripping portion “configured to be held by a user when using the applicator to apply the cosmetic product to a surface region of an individual,” as recited in claim 190.

Accordingly, for these additional reasons, the rejection of respective claims 151, 152, 179, 189, and 190 should be reversed.

IX. Conclusion

For the reasons given above, the Board of Patent Appeals and Interferences is respectfully requested to reverse the outstanding rejections so that claims 136-152, 156, 161, 163, 174, 175, 179, 189, and 190 may be allowed.

To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this Appeal Brief, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith,

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including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: December 23, 2003

By: 

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Appendix

136. A layered cosmetic product applicator, comprising:
an elongated flexible support including a first planar surface and a second planar surface, the first and second planar surfaces facing away from one another;
an application portion at a first end of the flexible support, the application portion being configured to apply cosmetic product to an individual;
a gripping portion at a second end of the flexible support opposite the first end; and
a layer of a first spongy flexible material on the first planar surface at the gripping portion, the first material having a greater flexibility than the flexibility of the support.

137. The applicator of claim 136, wherein the first and second planar surfaces are substantially parallel to one another.

138. The applicator of claim 136, wherein the flexible support comprises a material chosen from cardboard, plastic, leather, and foam.

139. The applicator of claim 136, wherein the flexible support comprises a material chosen from cardboard and leather.

140. The applicator of claim 136, wherein the application portion comprises one of a tuft of bristles, a pencil brush, a feather, a foam material, a sponge material, and a baize material.

141. The applicator of claim 136, wherein the first spongy flexible material comprises a closed-cell foam impervious to the cosmetic product.

142. The applicator of claim 136, wherein the first spongy flexible material is chosen from polyurethane, polyester, polyether, polyvinyl chloride, and polyethylene.

143. The applicator of claim 136, wherein the first spongy flexible material comprises one of flocking, a fabric layer covering, and a silicone layer covering.

144. The applicator of claim 136, wherein the first spongy flexible material is impregnated with at least one active cosmetic agent.

145. The applicator of claim 144, wherein the first spongy flexible material is impregnated with at least one of an anti-bactericidal agent, a fungicide, and an agent filtering ultra-violet radiation.

146. The applicator of claim 136, further comprising a layer of a second spongy flexible material on the flexible support.

147. The applicator of claim 146, wherein the first spongy flexible material is identical to the second spongy flexible material.

148. The applicator of claim 146, wherein the layer of the second spongy flexible material is on the first planar surface of the flexible support.

149. The applicator of claim 148, wherein the second spongy flexible material is at the application portion.

150. The applicator of claim 146, wherein the layer of the second spongy flexible material is on the second planar surface of the flexible support.

151. The applicator of claim 150, wherein at least part of the layer of the second spongy flexible material is at the gripping portion.

152. The applicator of claim 151, further comprising a layer of a third spongy flexible material at the application portion.

156. The applicator of claim 146, wherein the layer of the second spongy flexible material includes a thickness that is greater than a thickness of the flexible support.

161. The applicator of claim 136, wherein the layer of the first spongy flexible material includes a thickness that is greater than a thickness of the flexible support.

163. The applicator of claim 136, wherein the gripping portion is configured to be gripped between a user's finger and thumb.

174. A method of applying a cosmetic product to a surface region, comprising:
providing the cosmetic product applicator of claim 136;
loading the application portion of the cosmetic product applicator with a cosmetic product; and
transferring the cosmetic product from the application portion of the cosmetic product applicator to a surface region.

175. The method of claim 174, further comprising spreading the cosmetic product on the surface region.

179. The method of claim 174, further comprising gripping the gripping portion between a user's finger and thumb.

189. The applicator of claim 136, wherein the gripping portion is configured in the form of a handle.

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190. The applicator of claim 189, wherein the gripping portion is configured to be held by a user when using the applicator to apply the cosmetic product to a surface region of an individual.

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